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SIDLEY AUSTIN LLP			EXAMINER	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/668,100

## Applicant(s)

PALMER ET AL.

## Examiner

DAVID LAZARO

## Art Unit

2455

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 42-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

**DETAILED ACTION**

1. This office action is in response to the amendment filed 3/1/2010
2. Claims 42-48 were amended.
3. Claims 1-41 are canceled.
4. Claims 42-48 are pending in this office action.

***Response to Amendment***

5. The rejection of claims 42-48 under 35 USC 251 is withdrawn based on the amended claims now including the omitted limitations identified in the 04/16/09 Office Action.
6. The reissue declaration is now accepted based on the amended claims overcoming the rejection under 35 USC 251.
7. The examiner withdraws the rejection of claims 46-48 under 35 USC 112, first paragraph. The evidence provided in the 10/01/09 remarks under section V. is sufficient in providing support for the subject matter related to profiling.
8. The examiner withdraws the rejection of claims 42-48 under 35 USC 112, second paragraph, as the "selectively" language has been removed in the amended claims.
9. The examiner withdraws the rejection of claims 42-48 under 35 USC 101. The process claims are now positively tied to a particular machine based on the amended claims.
10. The 37 CFR 1.131 declaration is not deemed to be sufficient at this time as discussed below. As such, the rejections including Throckmorton as a reference are

maintained. A new grounds of rejection is made as necessitated by the amended claims.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 42, 43 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
13. Claim 42 is directed towards a method of providing education. However it is not clear as to how the body of the claim accomplishes the intended purpose of providing education. Claims 43 and 45 are dependent on claim 42 and similarly deficient. The examiner would consider the incorporation of claim 44 sufficient to overcome this rejection.

**37 CFR 1.131**

14. The declaration filed on 05/13/09 under 37 CFR 1.131 has been considered but is ineffective to overcome the U.S. Patent No. 5,818,441 (Throckmorton) reference. The examiner notes a similar discussion of the Conception evidence has occurred in the parent reissue application 09/860259. The response suggested by the applicant to

overcome the conception issues in the parent application would be suitable in overcoming the conception issues in the instant application.

**Conception:**

15. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Throckmorton reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

From MPEP 2138.04

*"Conception has been defined as "the complete performance of the mental part of the inventive act" and it is "the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice...." Townsend v. Smith, 36 F.2d 292, 295, 4 USPQ 269, 271 (CCPA 1930). "[C]onception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill." Hiatt v. Ziegler, 179 USPQ 757, 763 (Bd. Pat. Inter. 1973). Conception has also been defined as a disclosure of an invention which enables one skilled in the art to reduce the invention to a practical form without "exercise of the inventive faculty." Gunter v. Stream, 573 F.2d 77, 197 USPQ 482 (CCPA 1978). See also Coleman v. Dines, 754 F.2d 353, 224 USPQ 857 (Fed. Cir. 1985) (It is settled that in establishing conception a party must show possession of every feature recited in the count, and that every limitation of the count must have been known*

*to the inventor at the time of the alleged conception. Conception must be proved by corroborating evidence.); Hybritech Inc. v. Monoclonal Antibodies Inc., 802 F. 2d 1367, 1376, 231 USPQ 81, 87 (Fed. Cir. 1986) (Conception is the "formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice.")"*

The evidence is deficient in showing "a definite and permanent idea of the complete and operative invention" particularly in relation to the use of "an address identifying said data service" as claimed.

As noted by applicant, Exhibit C does reference a "URL", which is an internet address. However, Exhibit C only states, "Once the user's computer is connected to the central office or Roboweb computer service, the system can send the related URL's directly to the PC automatically". This is the first and only instance of a "URL" and the only evidence of an address. No further description or context is given as to the exact nature of a "related URL" and what the "related" language is relative to. Particularly, no clearly defined description is given specifically linking a "related URL" to a data service that corresponds to a program being broadcasted. Furthermore, there is no description of a URL being used as described by the claimed invention. The evidence does not disclose the receiving of URL at an address transmitter. As it is not clear as to the nature of the "related URL's", it is not clear whether they are necessarily separate from the audio or video information being broadcast (i.e. the URLs may be addresses for the broadcast information). The "related URL's" are not described as being used for automatically directing the computer to access the data services corresponding to the broadcast information. As such, the evidence does not disclose key concepts of the

invention regarding the usage of an address identifying a data service that provides information corresponding to audio or video programming being broadcasted.

It is important to note that in regards to the conception evidence, applicant points to other examples, such as "encoded data" in Exhibit C, as corroborating evidence of an address identifying the data service. However, the "encoded data" is not described as being an address to a data service. Instead, Exhibit C states "the system will use a central office to encode programming with appropriate time and content data." Exhibit C does not indicate the nature of "content data", and particularly does not describe the "content data" as being an address that identifies a data service corresponding to a broadcast programming. In other instances of information being sent in sync with a broadcast, Exhibit C uses various terminologies. This includes, "send the codes" (page 1 line 28), "with pages of graphics and textual information being sent in synch with the show" (page 2 lines 39-41) and "relative sync data" (page 2 line 64). None of these make reference to the information as specifically being or including address information identifying the data service corresponding to a broadcasted program.

### ***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 42, 43 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,818,441 by Throckmorton et al. (Throckmorton) in view of U.S.

Patent 5,878,222 by Harrison (Harrison)

18. With respect to claim 42, Throckmorton teaches a method of providing education comprising the steps of:

providing audio or video programming and an internet address to a broadcaster (Col. 3 lines 36-54, Col. 4 lines 1-33: primary stream transmitted and received can include broadcast programming, including television) wherein the Internet address is to be transmitted substantially simultaneously with the audio or video programming (Col. 3 lines 55 - Col. 4 line 33 and Col. 9 lines 1-15: associated data received can include an Internet address specifying a site. Associated data contains content corresponding to the programming);

providing a website specified by the Internet address, wherein the website contains information corresponding to the audio or video programming (Col. 3 lines 55 - Col. 4 line 33 and Col. 9 lines 1-15: associated data received can include an Internet address specifying a site. Associated data contains content corresponding to the programming)

connecting the website to computers of a plurality of users, wherein each user's computer initiates the connection in response to the transmitted Internet address (Col. 9 lines 1-14, Col. 3 lines 55-61 accessing the site using the received address while viewing the broadcast)



Throckmorton does not explicitly teach that the computers automatically initiate the connection without interaction by the user. Specifically, in a two-way communication mode, Throckmorton et al states that a user has to click on a reference to retrieve the information when the user is provided with "a menu [that] may list several references" [emphasis added by the examiner, col. 9, lines 11 - 14]. Throckmorton et al clearly anticipates that, during some situations, the menu has only one reference [one URL].

However, Throckmorton et al fails to discuss the interaction between the user and the computer when the menu only lists one reference [one URL]. In a one-way communication mode, Throckmorton et al teaches that it is possible "to display a page of [relevant] information without the user asking for it", col. 7, lines 22 - 23. In other words, when there is only one source of information relevant to the primary data stream, the information should be displayed with the primary data stream automatically without the user asking for it. As such, one skill in the art would have been motivated to look for such teaching in the two-way communication, i.e. to automatically access the on-line service and retrieve the associated information after receiving the URL.

Harrison teaches a two-way communication system for transmitting and receiving primary data stream and URL as associated data [col. 4, lines 23 - 37]. When the primary data stream is associated with one URL at a time, the computer automatically accesses the on-line service to retrieve the associated web page [462, fig. 4b, col. 6, lines 21 - 25, col. 8, lines 43 - 47] after receiving the URL [461, fig. 4b].

It would have been obvious to one of ordinary skill in the art to combine the teachings of Throckmorton et al and Harrison because they both teach a system for transmitting and receiving primary data stream and URL as associated data. Harrison's teaching of automatically accessing the on-line service to retrieve the web page after receiving the URL would allow Throckmorton et al to fulfill his requirement - providing relevant information to viewers without the viewer asking for it [Throckmorton et al, col. 7 lines 21-30].

19. With respect to claim 43, Throckmorton teaches a method as claimed in claim 42, wherein the internet address is transmitted separately from the broadcast (Col. 4 lines 1-20).

20. With respect to claim 45, Throckmorton teaches the method of claim 42 wherein the broadcast programming is a television program (Col. 6 lines 4-20)

21. Claims 44 and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,818,441 by Throckmorton et al. (Throckmorton) in view of Pitkow et al., "Using the Web as a survey tool: results from the second WWW user survey" Journal of Computer Networks and ISDN systems, vol. 27, 1995, pp.809-822 (12 pages) (hereinafter Pitkow) and U.S. Patent 5,878,222 by Harrison (Harrison)

22. With respect to claim 44, Throckmorton teaches a method as claimed in claim 42. but does not explicitly disclose

While Throckmorton teaches the associated data of a primary stream contains content corresponding to the primary data and that the associated may take the form of

a web site, Throckmorton only describes the associated content generically as ultimately the content used is up to the user when implementing/using the invention. As such, Throckmorton does not describe an exhaustive list of what the web sites may contain. Particularly, Throckmorton does not explicitly disclose providing one or more questions on the website corresponding to the content of the audio or video programming, wherein the website allows users to provide responses to the one or more questions; and recording the responses of the plurality of users to the one or more questions on the website. Pitkow shows that a web site is an advantageous method for providing questions in reference to a particular topic (pages 2-5, Fig. 1, "Overview" and "Architecture" survey home page provides access to sets of questions and provides advantages over other forms of surveys). Pitkow further shows that responses from the users and be collected and recorded to obtain a profile of users and their responses (Pages. 6-12 - Results-Conclusion and Appendix)

It would have been obvious to one of ordinary skill in the art to have the corresponding content of Throckmorton be questions and to obtain a profile of users and responses as shown in Pitkow. Throckmorton clearly intends any form of associated data to be used and recognizes the advantages of online/Internet formats of data. Using the known form of providing content as a web site containing questions requiring responses in providing associated data to a user in Throckmorton would have been obvious to one of ordinary skill in the art.

23. With respect to claim 46, Throckmorton a method of obtaining profiling data comprising the steps of:

providing audio or video programming and an internet address to a broadcaster (Col. 3 lines 36-54, Col. 4 lines 1-33: primary stream transmitted and received can include broadcast programming, including television) wherein the Internet address is to be transmitted substantially simultaneously with the audio or video programming (Col. 3 lines 55 - Col. 4 line 33 and Col. 9 lines 1-15: associated data received can include an Internet address specifying a site. Associated data contains content corresponding to the programming);

providing a website specified by the Internet address, wherein the website contains information corresponding to the audio or video programming (Col. 3 lines 55 - Col. 4 line 33 and Col. 9 lines 1-15: associated data received can include an Internet address specifying a site. Associated data contains content corresponding to the programming)

connecting the website to computers of a plurality of users, wherein each user's computer initiates the connection in response to the transmitted Internet address (Col. 9 lines 1-14, Col. 3 lines 55-61 accessing the site using the received address while viewing the broadcast)

While Throckmorton teaches the associated data of a primary stream contains content corresponding to the primary data and that the associated may take the form of a web site, Throckmorton only describes the associated content generically as ultimately the content used is up to the user when implementing/using the invention. As such, Throckmorton does not describe an exhaustive list of what the web sites may contain. Particularly, Throckmorton does not explicitly disclose the web site presents

one or more questions, allows users to provide responses to the one or more questions, recording the responses of the plurality of users to the one or more questions on the website, and summarizing the responses to obtain a profile of the users. Pitkow shows that a web site is an advantageous method for providing questions in reference to a particular topic (pages 2-5, Fig. 1, "Overview" and "Architecture" survey home page provides access to sets of questions and provides advantages over other forms of surveys). Pitkow further shows that responses from the users and be collected and summarized to obtain a profile of users and their responses (Pages. 6-12 - Results-Conclusion and Appendix)

It would have been obvious to one of ordinary skill in the art to have the corresponding content of Throckmorton be questions and to obtain a profile of users and responses as shown in Pitkow. Throckmorton clearly intends any form of associated data to be used and recognizes the advantages of online/Internet formats of data. Using the known form of providing content as a web site containing information requiring responses in providing associated data to a user in Throckmorton would have been obvious to one of ordinary skill in the art.

Throckmorton does not explicitly teach that the computers automatically initiate the connection without interaction by the user. Specifically, in a two-way communication mode, Throckmorton et al states that a user has to click on a reference to retrieve the information when the user is provided with "a menu [that] may list several references" [emphasis added by the examiner, col. 9, lines 11 - 14]. Throckmorton et al

clearly anticipates that, during some situations, the menu has only one reference [one URL].

However, Throckmorton et al fails to discuss the interaction between the user and the computer when the menu only lists one reference [one URL]. In a one-way communication mode, Throckmorton et al teaches that it is possible "to display a page of [relevant] information without the user asking for it", col. 7, lines 22 - 23. In other words, when there is only one source of information relevant to the primary data stream, the information should be displayed with the primary data stream automatically without the user asking for it. As such, one skill in the art would have been motivated to look for such teaching in the two-way communication, i.e. to automatically access the on-line service and retrieve the associated information after receiving the URL.

Harrison teaches a two-way communication system for transmitting and receiving primary data stream and URL as associated data [col. 4, lines 23 - 37]. When the primary data stream is associated with one URL at a time, the computer automatically accesses the on-line service to retrieve the associated web page [462, fig. 4b, col. 6, lines 21 - 25, col. 8, lines 43 - 47] after receiving the URL [461, fig. 4b].

It would have been obvious to one of ordinary skill in the art to combine the teachings of Throckmorton et al and Harrison because they both teach a system for transmitting and receiving primary data stream and URL as associated data. Harrison's teaching of automatically accessing the on-line service to retrieve the web page after receiving the URL would allow Throckmorton et al to fulfill his requirement - providing

relevant information to viewers without the viewer asking for it [Throckmorton et al, col. 7 lines 21-30].

24. With respect to claim 47, Throckmorton teaches a method as claimed in claim 46 wherein the internet address is transmitted separately from the broadcast (Col. 4 lines 1-20).

25. With respect to claim 48, Throckmorton teaches a method as claimed in claim 46 wherein the broadcast programming is a television program (Col. 6 lines 4-20)

### ***Conclusion***

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID LAZARO whose telephone number is (571)272-3986. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David Lazaro/  
Primary Examiner, Art Unit 2455  
May 10, 2010